08/682,483

Application Control Number: 08/682,483

UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/682,483	07/17/96	CANNON G	PF01251NA

DETAILED ACTION
LM02/0216

EXAMINER	
ART UNIT	PAPER NUMBER
2756	7

MOTOROLA INC
INTELLECTUAL PROPERTY DEPARTMENT
5401 NORTH BEACH STREET, MS E119
FORT WORTH TX 76137

DATE MAILED: 02/16/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

4 The following is a quotation of [illegible] which forms the basis for all obviousness rejections set forth in this Office action:

☒ This application has been examined ☒ Responsive to communication filed on 11/27/98 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

5 Claims [illegible] as being unpatentable over [illegible]

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-17 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 6-16, 23; Thus Kano discloses all the elements of the claimed invention except [illegible] are allowed.
4. ☒ Claims retrieving [illegible] are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on [illegible] has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

DETAILED ACTION

1. This application has been examined. Claims 1-17 are pending.

2. The amendment received on 11/27/98 (Paper # 6) has been entered.

3. The corrected or substitute drawings were received on 11/27/98. These drawings are subject to review and approval by the draftsman.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (US 5,487,100) in view of Morgan et al. (US 5,239,466) and Meske, Jr. (US 5,530,852).

Kane, an analogous electronic mail message delivery system, discloses operation to provide a server 102 with message inputs 104, 106, 108, 109 to receive email formatted messages and provide delivery to a remote selective call transceiver 134 which can originate a reply request via a communication terminal function 130, 141 (See Abstract, Fig. 1; col. 1, ln. 17 - col. 5, ln. 23). Thus, Kane discloses all of the elements of the claimed invention except for parsing retrieved information in a format configured for the receiver and directing the retrieved information to a second communicaiton device. In that Kane operates to connect with other networks for message information, the one of ordinary skill would have looked to the related messaging arts for information to implement the system. Morgan et al., a related system for routing messages, discloses that it was known to provide the capability of redirecting a message to another communication device 102, 104-109 through the server 101 of a wireless communication device 112 (See Abstract; Fig. 1-3; col. 2, ln. 29 - col. 3, ln. 68). Another related

system, Meske, Jr. et al., discloses that it was known to parse 400-430 information 410 at a message server 150 after retrieving 250, 220 it at the request of a user agent for presentation in a desired format at a the user's particular station 100 (Abstract; Fig. 4-5; col. 2, ln. 22 - col. 3, ln. 8; col. 5, ln. 17 - col. 6, ln. 36). Thus, the one of ordinary skill would have been aware of the teachings of the prior art for redirecting and reformatting messages for presentation. It would have been obvious to one of ordinary skill in the art to provide Kane's message delivery system with the message redirection function taught by Morgan et al. and the message parsing/reformatting function taught by Meske, Jr. et al., thereby resulting in the system and method of claims 1-17, since Morgan et al. suggests that forwarding capabilities are neccesary for users who travel away from their regular office location and Meske, Jr. et al. suggests that message parsing/reformatting will allow for a user device to utilize a single common display interface in order to simplify accessing different types of message information. Thus, providing a server or a selective communications transceiver either individually or in a common system operating in accordance with the claimed method of operation (as in claims 1-17) would have been obvious for one of ordinary skill in the art to provide for in accordance with the combination of references as discussed above.

6. Applicant's arguments filed 11/27/98 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., customizing information for a given selective call receiver) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the combination of the prior art does not show coupling the server to a distributed information source or originating a request to the server. The Examiner notes that Kane shows coupling a server 114 to an X.400 network at Figure 1 which suggests such connection. Further, the same figure shows a modem link 144, 146 back to the server through the PSTN which provides for message requests to the server from the remote unit and suggests the request operation. Thus, Applicant's arguments are not persuasive in this regard.

Applicant argues that the combination of the prior art does not show protocol selection operation or customization of messages for the selective call receiver. The Examiner notes that Morgan teaches at column 6, lines 26-43 that the transmitted message may be formatted for a particular receiver and transmitted using an alternative compression protocol and suggests the operative method and system claimed. Thus, Applicant's arguments are not persuasive on these points.

Applicant argues that the prior art does not show the server having a memory location for mapping selection commands for translating into retrieval commands to provide formatted information to the selective call receiver from the distributed informaiton source. The Exmainer notes that Meske shows at Figure 4 a server which uses programs executing in memory to retrieve news files from a news source in accordance with user selection inputs for formatting and providing the information to the user client which suggests the functions and operation claimed. Thus, Applicant's arguments are not persuasive regarding these elements.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the

state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The Examiner notes that Applicant seems to imply a narrower interpretation of the claim language than the plain meaning of the terms employed warrants. The Exmainer suggests that Applicant consider adding supporting phrases and limitations into the claims to specifically narrow their interpretation from the broad language presented for examination thus far.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Rinehart whose telephone number is (703) 305-4815. The examiner can normally be reached on Monday through Thursday from 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Supervisory Primary Examiner Frank J. Asta, can be reached on (703) 305-3817. The fax phone number for the Electrical Examining Technology Center is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mark H. Rinehart
Primary Examiner
Art Unit 2756

Mark H. Rinehart
Primary Examiner